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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re: Heinrich Lang, et al

Serial No.: 10/767,669

Filed: 01/29/2004

For: REARVIEW MIRROR ASSEMBLY FOR
MOTOR VEHICLES (As Amended)

Examiner: Ricky D. Shafer

Group No.: 2872

Docket No.: LMX-129 CON

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

TRANSMITTAL LETTER

Please find enclosed the following correspondence items to be file in the United States Patent and Trademark Office:

1. Petition under 35 CFR 1.144; and
2. Return Receipt Postcard.

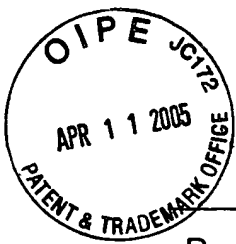
Please charge petition fee of \$250.00, or any other fees required, to Deposit Account No. 502079. A duplicate copy of this letter is enclosed.

Respectfully submitted,

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I hereby certify that this correspondence is being deposited with the United States Postal Service as "FIRST CLASS MAIL" with sufficient postage and mailing label affixed thereto, in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria VA 22313-1450, on April 7, 2005

By



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Dear Sir:

Petition under 35 CFR 1.144

Status

The application contains claims 10 and 13-23.

Claims 10 and 16, held to be drawn to an invention elected by the original presentation of claims, are believed to be in allowable condition. Claim 16 was objected to as being dependent on rejected claim 10. Claim 10 was rejected under the judicially created doctrine of obviousness-type double patenting. This rejection has been overcome and claim 10 is now indicated as allowable.

Claims 13-15 and 17-23 have been withdrawn from consideration as drawn to a non-elected invention.

This holding was traversed in the response of 3/03/05 and is the subject matter of the petition herewith filed.

Petition Under 35 CFR 1.144

Petition under 35 CFR 1.144, the restriction between Group I, i.e. claims 10 and 16 and Group II, i.e. claims 13-15 and 17-23, as set forth in the PTO Action of 2/04/04.

The inventions are said to be related as sub-combinations disclosed as usable together. The sub-combinations are said to be distinct if they can be shown to be separately usable. In the instant case, the examiner asserts that the mirror assembly of elected Group I has separate utility "as a rearview mirror assembly without the framing having a configured area to engage with the holding arm, the bracket having a configured area spaced from the upper and lower strips to engage with the holding arm and a plurality of connectors to engage with the positioning apparatus of the newly submitted invention." Further, "the newly submitted invention has separate utility as a rearview mirror assembly without a housing, a framing element having a first recess, a holding tube, a clamping part having a second recess and a snap connection---nor a positioning apparatus affixed to the carrier plate opposite the mirror pane and secured to the framing, a bracket releasably clamped to the framing, a first holding arm clampingly disposed between the upper strip and the framing and a second holding arm disposed between the lower strip and the framing." Reference is made to MPEP 806.05(d).

This holding is respectfully traversed as improper and is herein petitioned.

MPEP 806.05(d) requires that for restriction to be proper, the examiner must show that one of the combinations has utility other than in the disclosed combination.

It is argued that this has not been done, and that all claims are directed to the same invention in varying scope.

Claims 10 and 16 are directed to a rearview mirror assembly and include the below listed structural limitations:

a holding tube or arm 10;

a mirror element 6;

a framing 4 cooperating with a clamping part 8 to clamp with holding tube 10; (It is noted that clamping part 8 includes bracket 8, recess 16 and connector 26.)

hook and snap connectors 18, 22;

connectors 24, 26 securing the framing element 4 with holding tube 10.

Claims 13-15, 17-23 are directed to a mirror assembly which includes the following structures:

a holding arm 10;

a mirror element 6;

a framing 4 having a configured area 14 adapted to engage with arm 10;

a bracket 12 having a configured area 16 adapted to engage with arm 10;

connectors 14, 16, 24 and 26 adapted to engage framing 4 and bracket 12 securing bracket 12 with holding arm 10;

the framing and the bracket 4 and 12 including hook and snap connectors 18, 22 securing them together and with the holding arm;

configured areas, i.e. recesses 14 and 16, for securing the framing with arm 10.

Clearly, the claims of each Group call for the same structural elements, i.e. at least elements 4, 6, 10, 12, 16, 18, 22, 26, functioning in the same manner to carry out the same function and defining the same structure. It has not been shown that either of claims 10, 16 and claims 13-15, 17-23 have utility different from the disclosed utility.

MPEP 806.05(d) clearly states that the examiner must show another use for one of the sub-combinations. The paragraph clearly states that if the other use cannot be accomplished or is not reasonable the requirement should be withdrawn.

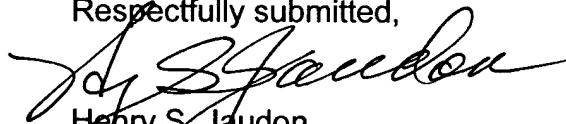
It is argued that the examiner has not suggested another use but has merely referenced structural limitations asserted to be omitted in claims 13-15, 17-23 which appear in the elected claims 10, 16. Also, the examiner asserts various limitations are added to claims 13-15, 17-23 which do not appear in claims 10, 16. No other use is proposed in the review of the claimed limitations.

As shown all claims include multiples of the same structural limitations of the disclosed mirror assembly. Such limitations restrict the claimed subject matter to the same use.

Further, it is pointed out that no undue hardship is placed upon the PTO as all claims under consideration are classified in Class 359, subclass 871, requiring only one search area.

Accordingly, it is urged that the restriction as set forth in the PTO Action of 2/04/05 is improper for the above stated reasons and withdrawal thereof is respectfully requested.

Respectfully submitted,



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